

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the apparatus must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are further objected to because Figure 1 is illegible due to darkness, shading, and font size. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior

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version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities:

No brief description of the drawings is provided.

Proper sectional headings have been omitted.

Appropriate correction is required.

### ***Claim Objections***

4. Claim 33 is objected to because of the following informalities:

The phrase “any of claim 18” is objected to because Examiner has no idea what it means.

The term “compouter” is incorrect.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner has no idea whatsoever what Applicant is attempting to say in claim 27.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's Specification.

Applicant's specification teaches us that repaired leather is well known. In regards to being produced by the method as taught by Applicant is reminded that in assessing the subject matter of product-by-process claims, it is necessary to bear in mind certain principles. Foremost among these is the principle that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969). Thus, the patentability of a product does not depend on the method of production. Thorpe, supra. If the product in a product-by-process claim is the same as or obvious from a product of the prior art,

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the claim is unpatentable even though the prior product was made by a different process.

Thorpe, *supra*; In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983). The Court of Customs and Patent Appeals discussed these principles as well as the rationale for rejection of such claims over prior art disclosures of products in In re Brown, 459 F.2d 531, 173 USPQ 685 (CCPA 1972) as follows:

In order to be patentable, a product must be novel, useful and unobvious. In our law, this is true whether the product is claimed by describing it, or by listing the process steps used to obtain it. This latter type of claim, usually called a product-by-process claim, does not inherently conflict with the second paragraph of 35 USC 112. [citation omitted] That method of claiming is therefore a perfectly acceptable one so long as the claims particularly point out and distinctly claim the product or genus of products for which protection is sought and satisfy the other requirements of the statute. It must be admitted, however, that the lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. (emphasis in the original, footnotes omitted).

Thus, although process limitations distinguishing the product over the prior art must be given the same consideration as traditional product characteristics, In re Hallman, 655 F.2d 212, 210 USPQ 609 (CCPA 1981), In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973), and although product-by-process claims are limited by and defined by the process, determination of patentability remains based upon the product itself, Thorpe, 227 USPQ at 966.

In view of the similarities between the claimed process, i.e. "preparing, recording, determining, repairing", and that of the prior art of Applicant's Specification, it is reasonable to

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believe that the product made by the prior art process would be either identical to or only slightly different from the claimed product. In such a situation, the burden of proof shifts to applicant to prove that the claimed product is materially different.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 18-30, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roever et al (6157730) in view of Applicant's Specification.

Roever teaches a method of inspecting leather, as well as the apparatus used, comprising preparation of the leather, optoelectronic recording of the surface of the leather, and determination of the number and size of defects present, wherein the apparatus comprises one or more cameras and sensors which are computer controlled (Figures). While Roever essentially teaches the invention as detailed, he fails to specifically teach repairing the leather based on the results with well known binders. Applicant's Specification, however, teaches us that it is well known in the art to repair leather hides with binders so as to reclaim product which would have otherwise been scrapped. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have utilized the repairing steps of the prior art with the inspection steps of Roever, so as to eliminate waste and save money. To repair defects as taught by Applicant's Specification, the leather must be inspected. Roever obviously teaches

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inspection, by means of automation. The claims as written provide no teachings other than the combination of two well known steps into one, all of which is well known in the art.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Herrmann (1610521), Nishikawa et al (4756947), and Barr et al (20050175229) all teach what is well known in the art.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaun R. Hurley whose telephone number is (571) 272-4986. The examiner can normally be reached on Mon - Fri, 8:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SRH  
16 April 2008

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